

Applicants hereby elect to prosecute the claims of group I, claims 1-7. This election is made without traverse with respect to groups II-IV and with traverse with respect to group V. Reconsideration is requested.

The Examiner is correct that the inventions of group I and group V have different functions at one level. Group I is directed to a method of enhancing bone formation or growth whereas group V is directed to a method to screen for a compound which will be successful in enhancing bone formation or growth or stimulating hair growth. However, it should be clear that the same search is involved in both cases. The method of enhancing bone formation or growth is based on use of compounds which inhibit the activity or production of NF- $\kappa$ B or that inhibit the activity or production of proteasomes. Claim 18, the sole claim in group V, is directed to an assay method for finding compounds which have the required inhibiting effect. *The invention in group V lies not in the nature of the assays, but in the application of these assays to identify bone growth enhancer or hair growth stimulators.* Thus, the same patentability considerations are relevant with respect to both groups. In view of this, applicants request that their election of group I be extended to group V as well.

#### **Preliminary Amendment**

Preliminary to the examination of the above-captioned application, please amend the application as follows.

#### **IN THE CLAIMS:**

Please cancel claims 2-4 without any prejudice and disclaimer.

Please replace claim 1 with the following clean set of amended claim 1. A mark-up version of the amended claim 1 is attached hereto as Exhibit A.

1. (Amended) A method to enhance bone formation or to treat pathological dental conditions or to treat degenerative joint conditions in a vertebrate animal which method comprises administering to a vertebrate animal in need of such treatment an effective amount of

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a compound that inhibits proteasomal activity and said compound being selected from the group consisting of a peptidyl aldehyde, pentoxifylline (PTX) and epoxomicin, whereby bone formation is enhanced or said pathological dental conditions or degenerative joint conditions is treated in said vertebrate animal.

Please add new claims 19-23 as follows:

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19. (new) The method of claim 1, wherein the compound is a peptidyl aldehyde.
  20. (new) The method of claim 1, wherein the compound is pentoxifylline (PTX).
  21. (new) The method of claim 1, wherein the compound is epoxomicin.
  22. (New) The method of claim 1, wherein the vertebrate animal is a human.
  23. (New) The method of claim 1, wherein the vertebrate animal is a non-human mammal.

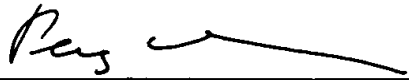
Upon entry of the present Preliminary Amendment, claims 1, 5-7 and 19-23 will be pending. Claim 1 is amended to incorporate the element of previous claim 4. Support for new claims 22-23 can be found throughout the application and, *inter alia*, at page 9, lines 23-28 of the present specification. Therefore, the above-described amendments do not introduce any new matter into the present application.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this

document to Deposit Account N . 03-1952 referencing 432722002621. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: October 18, 2001

Respectfully submitted,

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